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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,014	07/10/2003	Tao Nie	ITT-321-A	3070

7590 02/27/2007
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EXAMINER

HOOK, JAMES F

ART UNIT	PAPER NUMBER
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3754

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/617,014

Applicant(s)

NIE ET AL.

Examiner

James F. Hook

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-44 is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Reissue Applications

Claims 1-24 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The subject matter being removed from claim 1 was placed in the claim to overcome an art rejection, and therefore removal of such subject matter is improper recapture, where such is not permitted even if there was an original error in the claim language. In claim 15, the removal of fluoroplastic is likewise considered to be recapture when this limitation was added to overcome the art rejection and is being removed in the instant reissue application, which is not permitted.

Specification

The amendment filed July 10, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amendment to claim 6 creates new matter when such discloses fluoroplastics which is a broad limitation that encompasses all thermoplastics, however, the specification only lists a few actual fluoroplastic materials with regards to the second layer, therefore such is not the same scope as the specification sets forth and therefore is new matter with regards to fluoroplastics that would fall under the broad limitation of fluoroplastics other than those that are disclosed in the original specification with regards to the second layer. With respect to claim 7, the changing of the word "first" to "second" creates new matter when the original specification did not list that the fluoroplastic materials set forth as part of the make up of the second layer in claim 1 is also combined with the polyamides set forth in claim 6, therefore such is new matter when claim 1 requires at least a fluoroplastic and claim 6 sets forth a polyamide also being provided in the second layer, but the specification does not set forth that these two can be combined in the second layer. Claim 9 is also setting forth new matter in that the second layer is not disclosed to be able to consist of ethylene tetrafluoroethane, therefore such is considered new matter with respect to the second layer which isn't disclosed as being formed of this material.

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Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As set forth above in the objection to the specification, there is no original disclosure to support the changes to claims 6, 7, and 9, therefore these claims contain new matter in that the originally filed specification does not support the proposed changes.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noone (087) in view of Maillard. The patent to Noone discloses the recited multilayer tube comprising a first layer 18, of a melt processible thermoplastic provided with added material to make it an electric charge dissipating layer, such as carbon black, an

intermediate layer 16 made of a specific type of thermoplastic including polyvinylidene fluoride, a second layer formed from a thermoplastic material which can be a mixture of plastics such as polyvinylidene fluoride and polyamide, and a third layer which is made of a thermoplastic material such as polyamides and thermoplastic elastomers. The patent to Noone discloses all of the recited structure with the exception of forming the second layer of a plastic which contains at least one constituent which is chemically dissimilar from the thermoplastic material of the first layer in alloyed combination therewith. The patent to Maillard discloses the recited tube for conveying fuels comprising an inner layer 22 which can be made from a thermoplastic which can differ from the outer layer and can be vinyl fluoride which has an additive in it, and interior layer 28 which can be formed of a material different from the inside layer and can be polyvinylidene fluoride mixed with polyvinyl chloride, an intermediate layer 24 which can be formed of a thermoplastic material used to adhere layers together, a thermoplastic outer layer 30 which can include mixtures of polyvinylchlorides, polyolefins, and known elastomers of which rubber is a known natural elastomer, and an outer layer 26 can be formed of a thermoplastic of which nylon is one possible thermoplastic. All of the materials are considered extrudable and melt processible. The intermediate layer can be formed of a thermoplastic material that contains at least one constituent which is chemically dissimilar from the thermoplastic material of the inner layer in which it is in alloyed combination with. It would have been obvious to one skilled in the art to modify the second layer of Noone to be formed of a thermoplastic material that contains at least one constituent which is chemically dissimilar from the thermoplastic

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material of the inner layer in alloyed combination therewith to provide better bond between layers as suggested by Maillard where such would prevent premature failure thereby saving costs in replacement or repair.

Conclusion

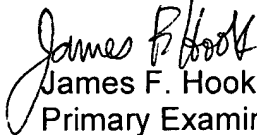
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Strassel and Brunnhofer disclosing a state of the art multilayered fuel tubes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-4903. The examiner can normally be reached on Monday to Wednesday, work at home Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


James F. Hook
Primary Examiner
Art Unit 3754

JFH